

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: October 9, 2002

STEPHEN D. DENTEL,
MICHAEL D. WHITMARSH,
JOHNATHAN R. VOGT
and KIRSTEN W. WISDOM

HP Docket No. 10992740-1

Serial No. : 09/629,254

Group Art Unit 3625

Filed : July 31, 2000

Examiner Jeffrey A. Smith

For : SYSTEM AND METHOD FOR FACILITATING THE
PURCHASE OF COMPATIBLE PRODUCTS

FAX RECEIVED

Assistant Commissioner for Patents
Washington, D.C. 20231

OFFICIAL

OCT 09 2002

Sir:

GROUP 3600

RESPONSE TO OFFICE ACTION

Reconsideration of the Office action dated July 9, 2002 and allowance of all pending claims are respectfully requested in view of the following remarks.

Applicants initially note that claims 1-23, 25 and 29-33 stand rejected under 35 USC 102(e) as being anticipated by Gronemeyer et al. (U.S. Patent No. 6,363,359). Claims 24 and 26-28 stand rejected under 35 USC 103(a) as unpatentable over Gronemeyer et al. (U.S. Patent No. 6,363,359) in view of Benjamin et al. (U.S. Patent No. 6,113,208).

Applicants note, however, that Gronemeyer et al. (U.S. Patent No. 6,363,359) indicates a filing date of December 21, 1999, less than 8 months prior to the filing date of applicants' pending application. Furthermore, applicants note that conception of their invention precedes the filing date of Gronemeyer et al., and that they diligently worked toward reducing their invention to practice from a time prior to the filing date of Gronemeyer et al. Applicants invention thus precedes the effective date of Gronemeyer et al.

Accordingly, pursuant to 37 CFR § 1.131, applicants hereby submit the attached Declaration of Stephen D. Dentel for the purpose of establishing invention of the subject matter of the rejected claims prior to the effective date of Gronemeyer et al. This declaration indicates conception at least as early as August 1999, when applicants began giving presentations regarding the invention to potential partners in developing a commercial implementation of the invention. Documentation demonstrating one such presentation is attached as Exhibit 1 to the Declaration of Stephen D. Dentel, such documentation bearing a date of October 11, 1999 (a date prior to the effective date of Gronemeyer et al.).

Following applicants' conception of the invention (and prior to the effective date of Gronemeyer et al.), applicants diligently worked toward reduction to practice of the invention. Such diligence is demonstrated by the Declaration of Stephen D. Dentel, and by the presentation documentation attached thereto as Exhibit 1. A commercial embodiment of the invention was completed by applicants' employer (and an implementation partner, AOL) in early 2000, and was released to the public for use in August 2000, further demonstrating applicants' diligence.

Therefore, in view of the attached Declaration of Stephen D. Dentel (and its Exhibit 1), Gronemeyer et al. should not be considered as prior art, and the Examiner's rejections under both 35 USC 102(e) and 35 USC 103(a) should be withdrawn.

////

////

////

////


////

The above remarks are believed to address fully the Examiner's rejections, and to place the application in condition for allowance. A prompt indication of the same respectfully is requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

Respectfully submitted,

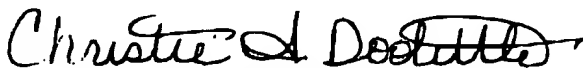
KOLISCH HARTWELL, P.C.




Walter W. Karnstein
Registration No. 35,565
Customer No. 23581
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicants

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner J. Smith, Group Art Unit 3625, Assistant Commissioner for Patents, at facsimile number (703) 305-7687 on October 9, 2002.



Christie A. Doolittle